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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,879	10/10/2001	Nobuo Oi	2185-0579P	4442

2292 7590 10/05/2004

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,879

Applicant(s)

OI ET AL.

Examiner

Jane Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,7,9,11,13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9,11,13,15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejection Repeated

1. The 35 U.S.C. 102(b) rejection over claims 1,3,5,7,9,11,13,15 anticipated by Oi et al. has been repeated for the reasons previously made in paper 3/16/2004.

Response to Arguments

2. Applicant's arguments filed 6/16/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the copolymer disclosed by EP '976 does not include ethylene, EP '976 discloses on page 3 lines 28-29, 'the copolymer of the present invention is a copolymer of an alpha-olefin with an alkenyl aromatic hydrocarbon wherein the copolymer has a structure in which tertiary carbon atoms are mutually separated by two successive methylene groups (*in other words, an ethylene group*) in the backbone of the copolymer'.

In response to applicant's argument that EP'976 does not disclose that copolymer comprises an alpha olefin that includes ethylene, the alpha olefin that EP'976 discloses is a vinylcyclohexane which is the vinyl compound that applicant claimed. The ethylene desired by the applicant is found in the backbone of the copolymer structure wherein the ethylene separates the tertiary carbon atoms. Therefore, the alpha olefin of the copolymer does not have to include an ethylene.

In response to applicant's argument that although EP'976 discloses that the alpha olefin includes vinylcyclohexane, EP'976 still fails to disclose a

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combination of ethylene with the vinyl compound recited in claim 1, such as vinylcyclohexane, applicant states in the argument on page 4 paragraph 2 that vinylcyclohexane is the combination of ethylene and the vinyl compound therefore, since EP'976 discloses that the alpha olefin includes vinylcyclohexane then EP'976 does not fail to disclose a combination of ethylene with the vinyl compound recited in claim 1. However, if applicant meant to argue that EP'976 fail to disclose a combination of ethylene and a vinyl compound, wherein the vinyl compound is vinylcyclohexane, EP'976 discloses that the copolymer is of an alpha-olefin with an alkenyl aromatic hydrocarbon wherein the copolymer has a structure in which tertiary carbon atoms are mutually separated by two successive methylene groups (*in other words, an ethylene group*) in the backbone of the copolymer', wherein the alpha olefin can comprise vinylcyclohexane (page 3 line 34).

Thus, in the absence of any evidence to the contrary, it remains the Examiner's position that the claimed invention is anticipated obvious over the prior art of record discussed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

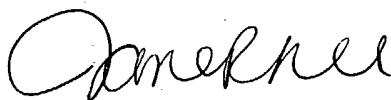
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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

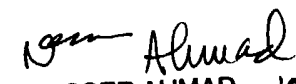
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
September 22, 2004


NASSER AHMAD
PRIMARY EXAMINER 10/01/04